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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,528	08/26/2003	Ryoji Watanabe	116871	2275
25944	7590	09/19/2007		
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			EXAMINER PAN, JOSEPH T	
			ART UNIT 2135	PAPER NUMBER
			MAIL DATE 09/19/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/647,528

Applicant(s)

WATANABE ET AL.

Examiner

Joseph Pan

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/2/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's response filed on June 27, 2007 has been carefully considered. Claims 1, 6, 9, 11, 13 and 14 have been amended. Claims 1-14 are pending.

Claim Objections

2. Claim 10 is objected to because of the following informalities: Claims 10 refers to "image display member", which is not directly to the subject of independent claim 9.

Claim 11, line 5, "the image display member" should be: the image display medium.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakagawa (U.S. Patent No. 6,931,541 B1) in view of Kadowaki (U.S. Patent No. 6,674,537 B2).

Referring to claim 1:

i. Nakagawa teaches:

an image forming system comprising:

an image display medium, that is a sheet of paper, on which a first image is displayed (see column 7, lines 63-67 'Note that the present invention may be applied to either a system constituted by a plurality of equipments (e.g., a host computer, an interface device, a reader, a printer, and the like), or an apparatus consisting of a single equipment (e.g., a copying machine, a facsimile apparatus, or the like).', of Nakagawa, emphasis added); and

an image forming apparatus (see figure 1, element 30 'scene synthesization circuit' of Nakagawa), wherein:

the image display medium includes a data supply apparatus, which stores therein data of a second image and authentication data used for an access authentication to the data of the second image and supplies the stored data of the second image and the stored authentication data to an external (see column 5, lines 34-43 of Nakagawa); and

the image forming apparatus includes:

an image reading section for reading the displayed first image (see column 7, lines 63-67; and figure 1, element 17 'motion image decoding circuit' of Nakagawa);

a data reading section for reading the supplied data of the second image and the supplied authentication data (see column 7, lines 63-67; and figure 1, element 17 'motion image decoding circuit' of Nakagawa);

an image forming section for forming the first image and the second image when the access to the data of the second image is authenticated, and for

forming the first image when authentication fails (see column 5, lines 34-43 of Nakagawa).

Nakagawa discloses that the invention may be applied to “an apparatus consisting of a single equipment (e.g., a **copying machine**, a **facsimile apparatus** or the like” (see column 7, lines 63-67 of Nakagawa). However, Nakagawa does not explicitly mention that the image display medium is a sheet of paper.

ii. Kadowaki teaches a data processing method in network system connected with image processing apparatus, wherein Kadowaki discloses that the color copying machine has a network scanner capable transmitting image data, that is obtained by reading a document image [i.e., a sheet of paper] (see column 21, lines 6-8 of Kadowaki).

iii. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Kadowaki into the method of Nakagawa to use a sheet of paper as an image display medium for a copying machine.

iv. The ordinary skilled person would have been motivated to have applied the teaching of Kadowaki into the system of Nakagawa to use a sheet of paper as an image display medium for a copying machine, because Nakagawa discloses that the invention may be applied to “an apparatus consisting of a single equipment (e.g., a **copying machine**, a **facsimile apparatus** or the like”, and it's well known that a sheet of paper is used as an image display medium for a copying machine, a facsimile apparatus or the like.

Referring to claim 9:

i. Nakagawa teaches:

An image display medium to display images, comprising:

A first image displayed on a surface of the image display medium, wherein the image display medium is a sheet of paper (see column 7, lines 63-67 'Note that the present invention may be applied to either a system constituted by a plurality of equipments (e.g., a host computer, an interface device, a reader, a printer,

and the like), or an apparatus consisting of a single equipment (e.g., a copying machine, a facsimile apparatus, or the like).', of Nakagawa, emphasis added); and

a data supply apparatus for storing data of a second image and supplying the stored data of the second image and the stored authentication data to an external (see figure 3; and column 5, lines 34-43 of Nakagawa).

Nakagawa discloses that the invention may be applied to "an apparatus consisting of a single equipment (e.g., a copying machine, a facsimile apparatus or the like" (see column 7, lines 63-67 of Nakagawa). However, Nakagawa does not expressly mention that the image display medium is a sheet of paper.

ii. Kadowaki teaches a data processing method in network system connected with image processing apparatus, wherein Kadowaki discloses that the color copying machine has a network scanner capable transmitting image data, that is obtained by reading a document image [i.e., a sheet of paper] (see column 21, lines 6-8 of Kadowaki).

iii. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Kadowaki into the method of Nakagawa to use a sheet of paper as an image display medium for a copying machine.

iv. The ordinary skilled person would have been motivated to have applied the teaching of Kadowaki into the system of Nakagawa to use a sheet of paper as an image display medium for a copying machine, because Nakagawa discloses that the invention may be applied to "an apparatus consisting of a single equipment (e.g., a copying machine, a facsimile apparatus or the like", and it's well known that a sheet of paper is used as an image display medium for a copying machine, a facsimile apparatus or the like.

Referring to claim 11:

i. Nakagawa teaches:

An image forming apparatus comprising:

an image reading section for reading a first image of a image display medium, wherein the image display medium is a sheet of paper (see column 7,

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lines 63-67 'Note that the present invention may be applied to either a system constituted by a plurality of equipments (e.g., a host computer, an interface device, a reader, a printer, and the like), or an apparatus consisting of a single equipment (e.g., a copying machine, a facsimile apparatus, or the like).', of Nakagawa, emphasis added);

a data reading section for reading data of a second image and authentication data from the image display member (see figure 3; and column 5, lines 34-43 of Nakagawa);

an authentication section for receiving access to the data of the second image and determining whether or not allowing the access to the data of the second image on the basis of the read authentication data (see figure 3; and column 5, lines 34-43 of Nakagawa); and

an image forming section for forming the first image and the second image when the access to the data of the second image is authenticated, and for forming the first image in other cases (see figure 3; and column 5, lines 34-43 of Nakagawa).

Nakagawa discloses that the invention may be applied to "an apparatus consisting of a single equipment (e.g., a copying machine, a facsimile apparatus or the like" (see column 7, lines 63-67 of Nakagawa). However, Nakagawa does not expressly mention that the image display medium is a sheet of paper.

ii. Kadowaki teaches a data processing method in network system connected with image processing apparatus, wherein Kadowaki discloses that the color copying machine has a network scanner capable transmitting image data, that is obtained by reading a document image [i.e., a sheet of paper] (see column 21, lines 6-8 of Kadowaki).

iii. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Kadowaki into the method of Nakagawa to use a sheet of paper as an image display medium for a copying machine.

iv. The ordinary skilled person would have been motivated to have applied the teaching of Kadowaki into the system of Nakagawa to use a sheet of paper as an image display medium for a copying machine, because Nakagawa discloses that the invention may be applied to “an apparatus consisting of a single equipment (e.g., a **copying machine, a facsimile apparatus** or the like”, and it’s well known that a sheet of paper is used as an image display medium for a copying machine, a facsimile apparatus or the like.

Referring to claims 13-14:

i. Nakagawa teaches:

An image forming method comprising:

supplying data of a second image and authentication (see figure 3; and column 5, lines 34-43 of Nakagawa);

reading a first image from the image display medium (see figure 3; and column 5, lines 34-43 of Nakagawa);

reading the supplied data of the second image and the supplied authentication data from the image display medium (see figure 3; and column 5, lines 34-43 of Nakagawa);

receiving access to the data of the second image (see figure 3; and column 5, lines 34-43 of Nakagawa);

determining whether or not the second image is authenticated based on the read authentication data and the received access data (see figure 3; and column 5, lines 34-43 of Nakagawa); and

forming the first image and the second image when access to the data of the second image is authenticated, and forming only the first image in the other cases (see figure 3; and column 5, lines 34-43 of Nakagawa).

Nakagawa discloses that the invention may be applied to “an apparatus consisting of a single equipment (e.g., a **copying machine, a facsimile apparatus** or the like” (see column 7, lines 63-67 of Nakagawa). However, Nakagawa does not expressly mention that the image display medium is a sheet of paper.

ii. Kadowaki teaches a data processing method in network system connected with image processing apparatus, wherein Kadowaki discloses that the color copying machine has a network scanner capable transmitting image data, that is obtained by reading a document image [i.e., a sheet of paper] (see column 21, lines 6-8 of Kadowaki).

iii. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Kadowaki into the method of Nakagawa to use a sheet of paper as an image display medium for a copying machine.

iv. The ordinary skilled person would have been motivated to have applied the teaching of Kadowaki into the system of Nakagawa to use a sheet of paper as an image display medium for a copying machine, because Nakagawa discloses that the invention may be applied to "an apparatus consisting of a single equipment (e.g., a **copying machine, a facsimile apparatus** or the like", and it's well known that a sheet of paper is used as an image display medium for a copying machine, a facsimile apparatus or the like.

Referring to claims 2-3, 10, 12:

Nakawaga and Kadowaki teach the claimed subject matter: an image forming system (see claim 1 above). They further disclose the encryption and the decryption (see column 2, lines 47-50 of Nakagawa).

Referring to claims 4-5:

Nakawaga and Kadowaki teach the claimed subject matter: an image forming system (see claim 1 above). They further disclose the authentication (see column 2, lines 47-50 of Nakagawa).

Referring to claim 6:

Nakawaga and Kadowaki teach the claimed subject matter: an image forming system (see claim 1 above). They further disclose the data supply apparatus is a non-contact memory (see column 16, lines 9-15 of Kadowaki).

Referring to claim 7:

Nakawaga and Kadowaki teach the claimed subject matter: an image forming system (see claim 1 above). They further disclose the password (see column 21, lines 38-40 of Kadowaki).

Referring to claim 8:

Nakawaga and Kadowaki teach the claimed subject matter: an image forming system (see claim 1 above). They further disclose the image forming section forms the second image in combination with the first image (see figure 3; and column 3, lines 34-43 of Nakagawa).

Response to Arguments

7. Applicant's arguments, filed on June 27, 2007, with respect to the that Nakagawa fails to disclose "an image display medium, wherein the image display medium is a sheet of paper", have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made.

Applicant argues:

"With respect to claims 13 and 14, Applicants respectfully assert that Nakagawa fails to disclose an image forming method or a computer program that causes a computer to read a first data and data of a second image and authentication data from an image display medium, as featured in independent claims 13 and 14 ." (see page 2, 1st paragraph, Applicant's Arguments/Remarks).

Examiner maintains:

Nakagawa discloses in figure 1, element 15 'scene description graphic decoding circuit' [i.e., reading first data], element 17 'motion image decoding circuit' [i.e., reading data of a second image], and element 20 'IPMP control unit' [i.e., reading authentication data], and element 1 'MPEG4 bit stream' [i.e., an image display medium].

Nakagawa then discloses "There is provided an information processing method/apparatus for demultiplexing object streams from a datastream which includes a plurality of object streams each having predetermined information, and decoding, synthesizing, and outputting the object streams, wherein the object streams are authenticated," (see also abstract, lines 1-6 of Nakagawa).

Nakagawa further discloses "The receiver, i.e., the player acquires information for decrypting (decoding) the encrypted data, or information required for authenticating the digital watermark when the user has paid a given fee for the copyrighted information, and decodes and plays back the data that have undergone the aforementioned process, and contain desired motion image data and audio data. Upon decrypting the encrypted data or authentication using the digital watermark, copyright protection is assured by limiting the number of times of copying of data or inhibiting a given object from being edited with other objects." (see column 1, lines 47-57 of Nakagawa, emphasis added).

Therefore, Nakagawa discloses an image forming method or a computer program that causes a computer to read a first data and data of a second image and authentication data from an image display medium, as featured in independent claims 13 and 14.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed

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within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

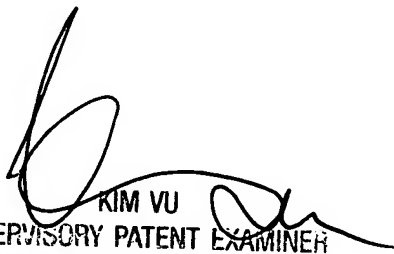
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Pan whose telephone number is 571-272-5987.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached at 571-272-3859. The fax and phone numbers for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.

Joseph Pan

September 7, 2007


KIM VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100